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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,199

04/13/2004

Akio Saiki

5000-5167

4036

85775 7590 11/10/2009  
Locke Lord Bissell & Liddell LLP  
Attn: IP Docketing  
Three World Financial Center  
New York, NY 10281-2101

EXAMINER

PARVINI, PEGAH

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

11/10/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptopatentcommunication@lockelord.com



<b>Office Action Summary</b>	<b>Application No.</b> 10/823,199	<b>Applicant(s)</b> SAIKI ET AL.	
	<b>Examiner</b> PEGAH PARVINI	<b>Art Unit</b> 1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,7 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 7, 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/21/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |



## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-4, 7 and 15-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,742,110 to Sakashita et al.

Regarding claims 1, 3-4, 7, and 15-20, Sakashita et al. disclose a polyamide moldable composition which has improved mechanical and thermal characteristics wherein said composition comprises polyamide-imide, a mixture of one or more fillers such as titanium oxide powder and polytetrafluoroethylene (i.e. PTFE) each in an amount of, preferably 0.5 to 50 parts by weight per 100 parts by weight of the polyamide and silane coupling agent which is used to treat the fillers (Abstract, column 1, line 60 to column 2, line 5; column 5, line 62 to column 6, line 47). Furthermore, Sakashita et al. teach an average particle size of 0.1 $\mu$ m to 200 $\mu$ m for the filler particles (i.e. titanium oxide particles) (column 6, lines 36-41).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have selected a particle size within the disclosed range of 0.1 $\mu$ m to 200 $\mu$ m since it has been held that where the general conditions of a claim are



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disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 105 USPQ 223 (CCPA 1955).

Although the reference may not expressly and literally disclose the amount of silane used, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have utilized an amount of silane which would have, at least, overlapping ranges with the ones instantly claimed since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

It is noted that the Sakashita et al. disclose overlapping ranges with reference to the amounts of the titanium oxide powder and PTFE compared with the ones instantly claimed, and overlapping ranges have been held to establish *prima facie* obviousness. MPEP § 2144.05.

With reference to the preamble reciting “A wear resistance and seizure resistance film formed on a sliding part”, it is noted that this is an intended use for the coating composition which follows this segment of the claim language. With reference to the statement of intended use, MPEP § 2111.02 states:

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

With reference to a film forming from said composition, it is noted that Sakashita et al. is drawn to a moldable composition with improved mechanical and thermal characteristics and to a composition which is excellent in molding characteristics.



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Therefore, it is the position of the examiner that the composition of Sakashita et al. may be molded in any form and shape such as into a film absence clear evidence showing the contrary.

With reference to the recitation drawn to the sliding parts being metal, it is noted that claim 1 is drawn to a composition forming film; thus, a recitation drawn to metal sliding parts as claimed in claim 19 does not impart any limitation on the composition of claim 1.

With reference to the limitation of claim 20 regarding how the film is obtained (i.e. “the film is obtained by mixing the coating composition by a solvent, applying the mixed composition to the sliding part, and heating the sliding part having the mixed composition applied thereto to cure the binder resin”), it is to be noted that this is a process limitation in a product claim. The limitations directed to the method for producing the claimed composition are not considered to add patentable weight to the examination of the product claims; it is well settled that if the examiner can find a product in the prior art that is the same or so similar as to have been obvious, the burden can be shifted to the applicant to demonstrate that the process for producing the composition somehow imparts a patentable weight to the composition under examination.

### ***Response to Amendment***

Applicants' amendment to claims 1 and 20, filed July 6, 2009, by inserting the limitation of claim 2 into the language of claims, is acknowledged. However, said



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amendment does not place the claim or application in condition for allowance as set forth above.

Applicants' amendment to claim 20, filed July 7, 2009, by changing the recitation of "obtainable" to "obtained" is acknowledged. Therefore, the rejection of said claim under 112-second paragraph due to the existence of "obtainable" language is withdrawn. However, said amendment does not place the claim or application in condition for allowance as set forth above.

### ***Response to Arguments***

Applicants' arguments, see pages 6-7, filed July 7, 2009, with respect to the 112-second paragraph rejection drawn to the content of components based on 100% of binder resin have been fully considered and are persuasive. The rejection of claims 1 and 20 under 112-second paragraph due to the above reason as detailed out in the previous Office action has been withdrawn.

Applicants' arguments with respect to McDermott et al. and Amou et al. have been considered but are moot in view of the new ground(s) of rejection presented above.



Applicants have argued that Sakashita et al. composition includes polyamide as a main component as opposed to polyimide or polamide-imide as the binder resin as recited in instant claims 1 and 20.

This argument is not found persuasive because the reference, which is drawn to a polyamide composition which is excellent in molding characteristics and has improved mechanical, thermal and strength characteristics, clearly discloses that said composition comprises polyamide-imide (i.e. binder), titanium dioxide (i.e. filler), silane (which treats the titanium dioxide), and polytetrafluoroethylene in overlapping ranges and particle size, wherever applicable (i.e. for titanium oxide particles), as known additives and components to be added to such a polyamide compositions. Therefore, the reference clearly teaches the instantly claimed composition, specially with respect to the components.

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGAH PARVINI whose telephone number is (571)272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.**



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegah Parvini/  
Examiner, Art Unit 1793

/Anthony J Green/  
Primary Examiner, Art Unit 1793